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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/731,651      | 12/07/2000  | Jerry Walter Malcolm | AUS9-2000-0655-US1  | 9971             |

45371 7590 07/13/2005

IBM CORPORATION (RUS)  
C/O SIEGESMUND & ASSOCIATES  
4627 NORTH CENTRAL EXPRESSWAY, SUITE 2000  
DALLAS, TX 75206

EXAMINER

BURGE, LONDRA C

ART UNIT PAPER NUMBER

2178

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/731,651

Applicant(s)

MALCOLM ET AL.

Examiner

Londra C Burge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-13, 15, 16, 18-20, 22-24 and 26-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-13, 15, 16, 18-20, 22-24 and 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### DETAILED ACTION

1. This action is responsive to communications: Amendment filed 8/6/2004.
2. Claims 1-9, 11-13, 15, 16, 18-20, 22-24 and 26-30. Claims 1, 12 and 22 are independent, claims 11, 14, 17, 21 and 25 have been cancelled and claims 26-30 have been added.
3. This action has been made Non-Final.

### *Claim Rejections - 35 USC § 102*

4. **The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1-7, 9, 11-13, 15, 18-20, 22-24, 26-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Markus et al. (herein after Markus) U.S. Patent No. 6,490,601 B1 filed 1/15/1999.**

**In regard to independent claim 1, Markus discloses *providing at least one field that is compliant with the standard, wherein at least one compliant database field may have a plurality of fields* (Markus Col 5 Lines 4-5 i.e. standard fields which are pre named and Col 22 Lines 33-37 i.e. plurality of fields); *providing and applying a set of rules* (Markus Col 7 Line 13 i.e. rules and requirements are set) *that select on field value from each compliant database field having a plurality of field values* (Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database); *matching each compliant database field with the corresponding compliant form field* (Markus Col 5 Lines 10-12 i.e. fields have been matched or mapped);**

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*inserting each selected field values into the corresponding compliant forma whereby a completed form is created* (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields).

**In regard to dependent claim 2, which depends on claim 1,** Markus discloses *responsive to application of a rule from said set of rules and selection of a field value, changing values in other related fields* (Markus Col 11 Lines 65-67 i.e. the user can adjust the form)

**In regard to dependent claim 3, which depends on claim 1,** Markus discloses *receiving the electronic form from a requester* (Markus Col 21 Lines 4-9 i.e. receiving a request for a form)

**In regard to dependent claim 4, which depends on claim 3,** Markus discloses *providing a network as a conduit for receiving the electronic form from the requester* (Markus Col 7 Lines 25-30 i.e. computers in a network)

**In regard to dependent claim 5, which depends on claim 1,** Markus discloses *transmitting the completed form across a network.* (Markus Col 7 Lines 25-30 i.e. computers in a network)

**In regard to dependent claim 6, which depends on claim 1,** Markus discloses *displaying the plurality of field values in at least one compliant database field having a plurality of field values* (Markus Col 5 Lines 4-5 i.e. standard fields which are pre named and Col 22 Lines 33-37 i.e. plurality of fields); *and selecting one of the field values so that the selected field value is inserted into corresponding compliant form field.* (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields)

**In regard to dependent claim 7, which depends on claim 1,** Markus discloses *providing at least one flag in the electronic form so that the flag determines which field value the rules select from each compliant database field having a plurality of field values.* (Markus Col 7 Lines 13 and Col 28 Lines 57-58 and Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database)

**In regard to dependent claim 9, which depends on claim 1,** Markus discloses *transmitting said the completed electronic form to a requester* (Markus Col 21 Lines 4-9 i.e. receiving a request for a form and transmitting it to the requester)

**In regard to dependent claim 11, which depends on claim 1,** Markus discloses *determining whether each selected field value inserted into the completed form is acceptable.* (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields and Col 11 Lines 64-67)

**In regard to independent claim 12,** claim 12 reflects similar subject matter claimed in claim 1 and is rejected along the same rationale.

**In regard to independent claim 13, which depends on claim 12,** claim 13 reflects similar subject matter claimed in claim 2 and is rejected along the same rationale.

**In regard to dependent claim 15, which depends on claim 12,** Markus discloses *at least one flag assigning at least one compliant form filed to a first category, and the computer program further comprises* (Markus Col 7 Lines 13 and Col 28 Lines 57-58 and Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database); *means for assigning a second category to at least one field value in each compliant database field having a plurality of field values; means for comparing the first category with the second category; and if the first*

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*category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field assigned to the first category. (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields) (Markus Col 7 Lines 13 and Col 28 Lines 57-58 and Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database)*

**In regard to dependent claim 18, which depends on claim 12,** Markus discloses *means for transmitting the completed electronic form to a requester* (Markus Col 21 Lines 4-9 i.e. receiving a request for a form and transmitting it to the requester)

**In regard to dependent claim 19, which depends on claim 12,** Markus discloses *means for displaying the plurality of values in at least one compliant database filed having a plurality of field values* (Markus Col 5 Lines 4-5 i.e. standard fields which are pre named and Col 22 Lines 33-37 i.e. plurality of fields); *means for a user to select one of the field values means for inserting the selected field value into the corresponding compliant form field and means for changing at least one other field value associated with a field of the electronic form.* (Markus Col 7 Lines 13 and Col 28 Lines 57-58 and Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database) (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields)

**In regard to independent claim 20, which depends on claim 12,** claim 20 reflects similar subject matter claimed in claim 11 and is rejected along the same rationale.

**In regard to independent claim 22,** Markus discloses *a first computer; a second computer coupled to the first computer through a communications medium; a first storage device coupled to the first computer* (Markus Col 7 Lines 25-30 i.e. computers in a network), *the first*

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*storage device comprising a database having at least one field that is compliant with the standard, wherein at least one compliant database fields may have a plurality of field values (Markus Col 5 Lines 4-5 i.e. standard fields which are pre named and Col 22 Lines 33-37 i.e. plurality of fields), and a set of rules that select one field value from each compliant database field having a plurality of field values; a second storage device coupled to the second computer, the second storage device containing the electronic (Markus Col 7 Line 13 i.e. rules and requirements are set) (Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database); and a controller coupled to the first storage devices operable to transfer the electronic form from the second storage device to the first storage device through the communications medium (Markus Col 7 Lines 25-30 i.e. computers in a network); apply the set of rules to select one field value from which compliant database field having a plurality of field values (Markus Col 7 Line 13 i.e. rules and requirements are set) (Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database); match each compliant database field with the corresponding compliant form field (Markus Col 5 Lines 10-12 i.e. fields have been matched or mapped); and insert each selected field value into the corresponding compliant form field; whereby a completed electronic form is produced. (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields).*

**In regard to dependent claim 23, which depends on claim 22,** Markus discloses *wherein the controller is further operable to display the electronic form and at least one field value from each compliant database field having a plurality of field values (Markus Col 7 Line 13 i.e. rules and requirements are set) (Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database)*

**In regard to dependent claim 24, which depends on claim 23,** Markus discloses *input device coupled to said controller and to said display device, the input device operable to select a field value from a first compliant database field having a plurality of field values* (Markus Col 7 Line 13 i.e. rules and requirements are set) (Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database); *and insert the selected field value into the electronic form* (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields).

**In regard to dependent claim 26, which depends on claim 24,** Markus discloses *change at least one field value in a second compliant database field in response to the selection of a field value from the first compliant database field* (Markus Col 11 Lines 65-67 i.e. the user can adjust the form)

**In regard to dependent claim 27, which depends on claim 26,** Markus discloses *transfer the completed form from the first storage device to the second storage device through the communications medium.* (Markus Col 7 Lines 25-30 i.e. computers in a network)

**In regard to dependent claim 29, which depends on claim 12,** Markus discloses *means for displaying the plurality of field values in at least one compliant database field having a plurality of field values* (Markus Col 5 Lines 4-5 i.e. standard fields which are pre named and Col 22 Lines 33-37 i.e. plurality of fields); *means for a user to select a field value from a first compliant database field having a plurality of field values* (Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database); *means for changing a field value in a second compliant database field in response to the user selecting a field value in the first compliant database field* (Markus Col 11 Lines 65-67 i.e. the user can adjust the form); *means*



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*for assigning a second category to at least one field value in each compliant database field having a plurality of field values* (Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database); *means for comparing the first category with the second category; if the first category is equivalent to the second category, means for inserting each field value assigned to the second category into each compliant form field assigned to the first category* (Markus Col 5 Lines 29-35 i.e. information is automatically inserted into the fields); *and means for transmitting the completed electronic form to a requester.* (Markus Col 21 Lines 4-9 i.e. receiving a request for a form and transmitting it to the requester)

### ***Claim Rejections - 35 USC § 103***

6. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 8 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus et al., in view of Allen et al. (herein after Allen) U.S. Patent No. 6,026,761 files 2/10/1997 provided by the applicant.**

**In regard to dependent claim 8, which depends on claim 1, Markus does not specifically mention *wherein the set of rules further resolve conflicts that may arise among field values*. However, Allen mentions the possibility of a non-agreement (Allen Col 33 Lines 36-37) reached between a requester and a delegate. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Allen to Markus, providing Markus the**

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benefit of having the option of agreements and non-agreement which could result in the termination of a process if there is a conflict as taught by Allen Col 33 Lines 34-39.

**In regard to dependent claim 16**, Claim 16 reflects the similar subject matter as claimed in claim 8 and is rejected along the same rationale.

8. **Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Markus et al., in view of Higley U.S. Patent No. 6,065,048 filed 10/29/1997 provided by the applicant provided by the applicant.**

**In regard to dependent claim 28, which depends on claim 12**, Markus does not specifically mention *means is a web browser that connects to the network and retrieves the electronic form from a server using a MIME protocol*. However, Higley mentions that a MIME protocol is used (Higley Col 6 Lines 49-67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply Higley to Markus, providing Markus the benefit of using a MIME protocol which would enhance the capabilities of the process.

**In regard to dependent claim 30**, Claim 30 reflects the similar subject matter as claimed in claim 28 and is rejected along the same rationale.

#### ***Response to Arguments***

9. **Applicant's arguments with respect to claims 1-9, 11-13, 15, 16, 18-20, 22-24 and 26-30 have been considered but are moot in view of the new ground(s) of rejection.**

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The applicant argues that the set of rules that determines which values are selected from the database to populate each field (Page 5 Para 2). Markus Figures 8A-8E i.e. shows a plurality of field values that can be selected from a database.

### *Conclusion*

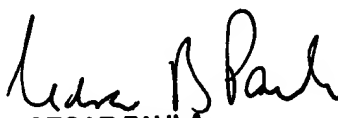
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Londra C Burge whose telephone number is (571) 272-4122.

The examiner can normally be reached on 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LCB  
6/29/2005

  
**CESAR PAULA**  
**PRIMARY EXAMINER**